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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,176	04/04/2001	Norihito Morikage	259A 3065	2869
7590 12/16/2004			EXAMINER	
KODA & ANDROLIA 2029 CENTURY PARK EAST LOS ANGELES, CA 90067-3024			ALAUBAIDI, HAYTHIM J	
			ART UNIT	PAPER NUMBER
			2161	
DATE MAILED: 12/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,176

Applicant(s)

MORIKAGE ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-16, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4, 6, 16 and 20 is/are allowed.
- 6) ☒ Claim(s) 3, 5 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the amendment of June 9, 2004.
2. Claims 1-6, 13-16, 18 and 20 are presented for examination following the amendment of June 9, 2004
3. Claims 5 and 15, is rejected under 35 U.S.C. 102(e).
4. Claims 3 and 13-14 and is rejected under 35 U.S.C. 103(a)
5. Claims 1-2, 4, 6, 16 and 20 are allowed over the prior art of record.
6. Claim 18, is objected to as being dependent upon a rejected base claim.
7. The Examiner acknowledges Applicants corrections in regard to Claims 1-2 and 20 to overcome the 112 rejections.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 3 and 5 recites the limitation "whereby retrieval can be easily and efficiently performed with knowledge of the law". There is insufficient antecedent basis for this limitation in the Specification of the current application. According to the specification on Page 3, Lines 22-23, no knowledge of technical law terms are required.

The Examiner believes that this may be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 5 and 15, is rejected under 35 U.S.C. 102(e) as being anticipated by Nicholas J. Davies (U.S. Patent No. 6,353,827 and Davies hereinafter).

Regarding Claims 5 and 15, Davies discloses:

a verb and object database constructed by associated verbs and objects related to each other (Abstract; see also Col 2, Lines 17-29; see also Col 12, Lines 51-54)

and by associated retrieval keywords related to the combination of them (verb and object) (Col 12, Lines 51-54)

a retrieval processing portion for obtaining a retrieval keyword associated with a combination of a received verb and object (Col 3, Lines 36-41; see also Col 6, Line 6 through Col 7, Line 8; see also Col 16, Lines 1-5).

whereby retrieval can be easily and efficiently performed with knowledge of the law (this feature is inherent, as every person in the United States under federal and state jurisprudence is assumed to know the law).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3 and 13-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael Walfish (U.S. Patent No. 6,047,300 and Walfish hereinafter) in view of Aristotle Balogh (U.S. Patent No. 5,893,101 and Balogh hereinafter).

Regarding Claims 3 and 13-14, Walfish discloses:

associating non-retrieval keywords (misspelled) with retrieval keywords adequate for replacing the non-retrieval keywords (Col 2, Lines 48-58)

an information analysis portion for determining whether or not a received keyword is a non-retrieval keyword (Col 2, Line 65-67)

a retrieval processing portion when the determination for the keyword is a non-retrieval keyword, the system will read the associated retrieval keyword (Col 2, Line 67 through Col 3, Line 13); and

whereby retrieval can be easily and efficiently performed with knowledge of the law (this feature is inherent, as every person in the United States under federal and state jurisprudence is assumed to know the law).

Walfish reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the meta-keyword database. However Balogh teaches a meta-keyword database (Abstract; see also Col 1, Lines 57-64).

Given the intended broad application of Walfish's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Walfish with the teachings of Balogh to include a database storage for the metadata (meta-keyword) and not just the memory of the PC that was stated by Walfish, as the reference is teaching at the PC level of a word processing document, and it would be obvious to substitute the memory with a database to increase the systems performance and allow for a larger storage in addition to maximizing the retrieval speed of the keyword.

Allowable Subject Matter

14. Claims 1-2, 4, 6, 16 and 20 are allowable over the prior art of record.
15. Claim 18 is objected to as it depends on a rejected base claim (Claims 13-15), but would have been allowed if it contains all of the limitations of allowed Claim 16.

16. The following is the Examiner's statement of reasons for the indication of allowable subject matter:

Regarding Independent Claims 1-2 and 20, Applicant's particular system for query pattern prediction is the combination of predicting an information gathering query patterns for law cases by constructing a database that associate verbs and objects related to each other and associating retrievable keywords related to the combination of them (verb and object); in combination with the limitation of matching a retrieval pattern by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

Regarding Claim 4, Applicant's particular system is wherein the meta-keyword database is set such that the non-retrieval keyword and a law term having meaning equal or similar thereto as the retrieval word associated with the non-retrieval keyword are on-to-one or on-to-many in combination with the limitation of matching a retrieval pattern by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

Regarding Claims 6, 16 and 18, Applicant's particular system is the combination of having an information analysis portion to determine whether the received keyword is a

verb or an object; and for reading the other object or verb associated therewith; in combination with the retrieval processing portion that receives the other verb or object after the output of the input/output processing portion to obtain a retrieval keyword associated with a combination of the verb and the object in combination with the limitation of matching a retrieval pattern by a received retrieved keyword with a pattern of an aid flowchart in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

Response to Arguments

17. Applicant's arguments filed in the amendment of June 9, 2004 have been fully considered but they are not persuasive.

a- Applicant argues on (page 8, 4th paragraph) that the Davies does not suggest such a system could be utilized as a law retrieval apparatus and particularly as a law retrieval apparatus comprising a verb and object database constructed by Associating a verbs and objects related to each other and by associating keywords. The Examiner however, respectfully disagrees. Davies discloses all the above (see Examiner's rejection above).

b- Applicant argues on Page 9, Paragraphs 1 and 2, that Walfish does not teach associating non-retrieval keywords (misspelled) with retrieval keywords adequate for replacing the non-retrieval keywords (first limitation of Claim 3). The Examiner however

respectfully disagrees. This limitation was addressed in rejecting Claim 3; see also (Col 2, Lines 48-58).

c- Applicant argues on Page 9, 3rd Paragraph, regarding to combining the two references for Balogh and Walfish is not proper. The Examiner however respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the general knowledge available to an ordinary skilled in the art would be the ability to maximize the speed and the performance of a system by increasing the memory storage to be able to store more documents and more keywords.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Points of Contact

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
Art Unit 2161
December 13, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100